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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,600	12/13/2004	Haruo Sugiyama	0020-5329PUS1	4687
22850	7590	04/12/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
31 DAYS	04/12/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 04/12/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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## Office Action Summary

**Application No.**

10/517,600

**Applicant(s)**

SUGIYAMA ET AL.

**Examiner**

Maury Audet

**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-19,21,22 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6,8,10-19,21,22 and 25-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The present application has been transferred from former Examiner Young to the present Examiner.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1-7, 18, 19, and 22, drawn to a peptide, or a cancer vaccine or pharmaceutical composition comprising said peptide, said peptide being a distinct peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct peptide sequence as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

II. Claims 13 and 18, drawn to an antibody to peptide, or cancer vaccine or pharmaceutical composition consisting of a peptide of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct antibody as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

III. Claims 8-11, 22, 26-28, and 31, drawn to a polynucleotide encoding a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68; or a vector or cell expressing a vector comprising said polynucleotide. Applicant is to select one distinct polynucleotide as the

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invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

IV. Claims 14, 15, 19, 22, 29, and 32, drawn to a cell presenting antigens to a peptide an antibody to peptide, or cancer vaccine or pharmaceutical composition consisting of a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct cell presenting antigen as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

V. Claims 16, 17, 22, and 30, drawn to a cytotoxic T-lymphocyte (CTL) comprising a complex between an HLA-A24 antigen to a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct CTL complex as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

VI. Claim 12, drawn to a method of making a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct peptide as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

VII. Claim 21 and 25, drawn to a method for treatment or prevention of cancer with a peptide of SEQ ID NO: 7 or a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct peptide as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

VIII. Claims 25 and 33-34, drawn to a method for treatment or prevention of cancer using a polynucleotide encoding a peptide of SEQ ID NOS: 7 or a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68; or a vector or cell expressing a vector comprising said polynucleotide. Applicant is to select one distinct peptide as the invention. This is an

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election of invention under Section 131, 35 USC, and not an election of species.

IX. Claim 25 and 35, drawn to a method for treatment or prevention of cancer using an antigen presenting cell, peptide of SEQ ID NO: 7 or a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68 complexed to an HLA-A24 antigen. Applicant is to select one distinct peptide as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

X. Claim 25 and 33, drawn to a method for treatment or prevention of cancer with a cytotoxic T-lymphocyte (CTL) comprising a complex between an HLA-A24 antigen to a peptide of SEQ ID NO: 7 or a peptide selected from the group consisting of SEQ ID NOS: 2-6 and 66-68. Applicant is to select one distinct CTL complex as the invention. This is an election of invention under Section 131, 35 USC, and not an election of species.

### *Lack of Unity*

An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) a product and a process specially adapted for the manufacture of said product; or (2) a product and a process of use of said product; or (3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or (4) a process and an apparatus or means specifically designed for carrying out the said process; or (5) a product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).

### **Peptide Markush Group-Lack of Unity**

The inventions are independently drawn to a markush group of distinct peptides (see above: SEQ ID NOS: 6-7 and 66-68). For the members of a Markush group to have unity of invention, *all* members must have a common core structure or be a member of an art recognized class. Neither of the above applies to the peptides of the present invention. Thus, the Markush groups, and hence Inventions drawn thereto, lack unity of invention. (See Annex B to PCT Administrative Instructions, P. A1-59).

### ***Requirement for a Peptide or Other Compound as to Peptide as Election as the Invention***

As described above, the distinct peptides do not contain a substantial, distinguishable core structure/sequence that runs through them respectively. Thus an individual sequence and/or structure search is required of each compound of the invention. Therefore, irrespective of which Group is elected as the invention, Applicant must elect a single peptide sequence or compound containing, as the invention, to which the elected Invention group will be searched.

**This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CRF 1.143).

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Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***In re Ochiai/Brouwer Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 04/2/2007

A handwritten signature in black ink, appearing to read 'Maury Audet', written over a horizontal line.

MAURY AUDET  
PATENT EXAMINER